

PATENT APPLICATION

DAC/2827
AF/2827

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q56857

Yasuyoshi YAMADA

Appln. No.: 09/435,448

Group Art Unit: 2827

Confirmation No.: 5236

Examiner: Graybill, David E.

Filed: November 22, 1999

For: BACK ELECTRODE TYPE ELECTRONIC PART AND ELECTRONIC ASSEMBLY
WITH THE SAME MOUNTED ON PRINTED CIRCUIT BOARD

**PETITION TO WITHDRAW THE FINALITY OF THE MAY 20, 2003 OFFICE
ACTION UNDER 37 C.F.R. § 1.81**

Group Director, Group 2800
Washington, D.C. 20231

Sir:

Applicant respectfully submits that the "final" Office Action mailed May 20, 2003 has improperly been made "final." Applicant respectfully solicits the withdrawal of the "finality."

MPEP § 706.07(a) indicates that a "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) ..." (emphasis added).

In the May 20, 2003 Office Action, the Examiner has introduced new grounds of rejection against independent claims 1 and 7. Specifically, claim 1 has been rejected under 35 U.S.C. § 102 as being alternatively anticipated by JP 10-56093¹ or US 6,018,462², and claim 7 has been rejected under 35 U.S.C. § 102 as being anticipated by JP 10-56093.


¹ The Examiner has waited until the *fourth* Action on the merits to utilize JP 10-56093 in an anticipatory rejection of the independent claims (which have not been substantively amended). It is difficult to understand the Examiner's delay in applying what he alleges to be an anticipatory reference.

These new rejections were not necessitated by applicant's amendment. Specifically, claim 1 was not amended in response to the August 21, 2002 First Office Action, and claim 7 was only amended to correct an informality.

Further, these new rejections were not based upon information submitted in an information disclosure statement (IDS) during the 37 C.F.R. § 1.97(c) period (*i.e.*, between the August 21, 2002 first Office Action and the instant Office Action). US 6,018,462 was cited by the Examiner in the August 21, 2002 Office Action, and JP 10-56093 was provided to the Examiner via an IDS filed with the Application on November 22, 1999, which was long before the required period.

Thus, for *at least* the above reasons, Applicant respectfully submits that this is an improper "final" Office Action, and requests the corresponding withdrawal of the "finality."

Respectfully submitted,



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PATENT TRADEMARK OFFICE

Date: June 19, 2003

² For a reason that is unclear to Applicant, the Examiner has waited until the May 20, 2003 Office Action to utilize Sakuyama in an anticipatory rejection of the independent claims. It is difficult to understand the Examiner's delay in applying what he alleges to be an anticipatory reference.